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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,967	09/17/1999	JAMES IHLE	0656.0370004	9463

26111 7590 06/22/2004

STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

NGUYEN, QUANG

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/397,967	<b>Applicant(s)</b> IHLE ET AL.	
	<b>Examiner</b> Quang Nguyen, Ph.D.	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 35,36,42,45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35,36 and 42 is/are rejected.
- 7) ☒ Claim(s) 45 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Sequence search</u>                    |

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Amended claims 35-36, 42, 45-46 are pending in the present application.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 5/12/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,136,595 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Priority***

The present application is a continuation of U.S. Serial No. 08/665,574, filed June 18, 1996, now U.S. Patent No. 6,136,595, which is a division of U.S. Serial No. 08/282,012, filed July 29, 1994, now abandoned, which is a continuation-in-part of U.S. Serial No. 08/097,997, filed July 29, 1993, now U.S. Patent No. 5,728,536.

Upon review of the specifications of the U.S. Serial Nos. 08/665,574, 08/282,012, 08/097,997, and comparison with the specification of the present application, it is determined that the pending claims are only entitled to the priority benefit of the filing date of July 29, 1994. This is because there is no teachings or written support for a DNA sequence encoding Jak3 of SEQ ID NO:16 in the specification of the U.S. Serial No. 08/097,997.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42, it is unclear what is encompassed by the phrase "said peptide the Jak3 autophosphorylation site". What is the relationship between the peptide and the Jak3 autophosphorylation site? The metes and bounds of the claim are not clearly determined.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Wilks et al. (WO 92/10519; IDS). **This is a new ground of rejection.**

Wilks et al. disclose an isolated nucleic acid sequence of murine JAK2 that has nucleic acid sequences encoded the same amino acid residues 657-668, 942-953 and 1003-1018 of JAK3 peptides of SEQ ID NO:16 (see Fig. 8, and the attached sequence

search). Therefore, the isolated nucleic acid sequence of Wilks et al. will hybridize to a DNA sequence encoding amino acids of a Jak3 peptide of SEQ ID NO:16 under the recited conditions because of the presence of nucleic acid sequences encoding significant identical stretches of amino acid residues.

Accordingly, Wilks et al. anticipate the instant claim.

Claims 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Littman et al. (Nature 326:85-88, 1987). **This is a new ground of rejection.**

Littman et al. disclose a cDNA sequence comprising the amino acid sequence KDYY of SEQ ID NO:16, and at least one conservative amino acid substitution in the flanking sequences of the KDYY (see Fig. 2).

Accordingly, the teachings of Littman et al. meet all the limitation of the instant claims. Therefore, Littman et al. anticipate the instant claims.

### ***Conclusions***

#### ***No claims are allowed.***

Claims 45-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (571) 272-0776.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, David Guzo, Ph.D., may be reached at (571) 272-0767, or SPE, Irem Yucel, Ph.D., at (571) 272-0781.


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To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636; Central Fax No. (703) 872-9306.

Quang Nguyen, Ph.D.

  
DAVID GUZO  
PRIMARY EXAMINER  
8/2/02